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EXAMINER

PATEL, S

ART UNIT

PAPER NUMBER

1624

DATE MAILED:

05/22/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/272,916**

Applicant(s)  
**Klaus-Jurgen Pees et al.**

Examiner  
**Sudhaker Patel**

Group Art Unit  
**1624**



☐ Responsive to communication(s) filed on \_\_\_\_\_

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

- ☒ Claim(s) 1-9 is/are pending in the application.
- Of the above, claim(s) 5 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-4 and 6-9 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### DETAILED ACTION

Applicants' communication wide paper #7 dated 5/1/00 is acknowledged.

Claims 1-4, 6-9 are pending in this application.

Amendments to claims 1, 6, cancellation of claim 5, and addition of new claim 9 have been considered but not found persuasive for following reasons.

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4, 6-9 are rejected are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.1). In evaluating the enablement question, several factors are to be considered. In re Wands, 8 USPQ 2d 1400 (Fed. Cir. 1988); Ex parte Forman, 230 USPQ 546. The factors include: (1). The nature of invention; (2). the state of prior art ; (3). the predictability or lack thereof in the art; (4). the amount of direction or guidance present; (5). the presence or absence of working examples; (6). the breadth of the claims, and (7). the quantity of experimentation needed.

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The nature of the invention in the instant case has generic claims which embrace a wide range of chemically and physically distinct compounds wherein applicants claim different types of substituted novel 6-phenyl- triazolo(1,5-a)-pyrimidine substituted Derivatives as represented by a generic Formula II.

1) Specification is not adequately enabled for the scope of diverse groups such as C1-10 alkyl C2-10/alkenyl/C3-C10 alkadienyl or phenyl group, each independently optionally substituted by one or more halogen atoms or nitro, cyano, C3-6 cycloalkyl, C3-6 cycloalkenyl, C1-6 haloalkyl, C3-6 halocycloalkyl, C1-6 alkoxy, C1-6 haloalkoxy, tri C1-4 alkyl silyl, phenyl, halo or dihalo-phenyl or pyridyl groups for R2 as defined in specification on pages 3-6 which may/may not be optionally substituted together with carbon atoms 1-10 group together with new proviso as outlined in amended claim 1 for groups involving L1 through L5 representing H, Halogen, alkyl, alkoxy, -N02 etc. for which there is no mention of use of the same with raw materials together with 5-halo group of the base core triazolo(1,5-a)-pyrimidine either in specification or claims. Such compounds range from fully saturated to semi- saturated in nature optionally substituted with 1 or more substituents for which there is no reasonable basis for assuming that the myriad of compounds embraced by the claims will all share the same fungicitoxy and enhanced systemicity since they are so structurally dissimilar as to be chemically non-equivalent and there is no basis in the prior art for assuming the same. Note In re Surrey 151 USPQ 724 regarding sufficiency of disclosure for the Markush group.

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No evidence of systemicity and enhanced fungitoxicity equivalence is seen for various meanings of group R2, and variables L1 through L5 together with carriers and adjuvants thereof for Formula(I) as described in amended claim 1 will all share the requisite profile activity needed to be operative for practicing the invention. Specification on page 4 lines 3-17 merely points “ the compounds exhibit valuable fungicidal properties, especially..... within a wide concentration range and may be used in agriculture without significant difficulties”. Note, applicants have not provided any test data &/or assay, and other tests not only for the instantly claimed novel compounds and their comparison of performance with currently available market & art recognized reference samples, if any. Applicants just mention on lines 24-25 “especially good results in terms of control of phytopathogenic fungi are obtained by the compound of claim 9.

Furthermore applicants have requested to amend claims 1,6. Note , for amended claim 1 definition of R2 as presented in the specification on pages 2-4 , represent as preferred embodiment.... wherein R2 represents a H or a C1-10 alkyl group or a C3-10 alkenyl group (see lines 30-32 on page 4). Further more on page 4 lines 9-13 R2 is defined as “ any alkenyl or alkynyl part of the substituents.....and/or R2 contains upto 10 carbon atoms, preferably upto 9 carbon atoms, more preferably upto 6 carbon atoms, and ...”. there is nowhere mention of specific -C10 alkenyl, C2-C10 alkynyl, C3-C10 alkadienyl in the specification.

Also, the definitions of L1 through L2 as presented in amended claim 1 especially “..... provided further that L3 is not alkoxy when L2 and L4 are both H..)” is not exactly as claimed in

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specification on page 3 lines 1-3 (= L1 through L5 each .... H, or Halogen, or an alkyl, alkoxy, or -N02 group, provided that at least one of L1 through L5 represents a -N02 or alkoxy group”.

There is no mention of specific L3 i.e. 4 position of phenyl ring not to be alkoxy group. Claim 1 and claims dependent on claim 1 are rejected because applicants are requesting amendments to claims 1, 6 by way of adding new matter to eliminate rejections under 102/103 reference Pfengle '534, and current inventor's (Pees) earlier work references USP '996; '783 which encompass instantly claimed modifications in the reference core structure which is “ Substituted Pheny-Triazolopyrimidine Fungicides”.

### *Specification*

2. As discussed above in 112 para one rejections for claim 1 and dependent claims on claim 1 the amendments for claims 1,6 as filed on 5/1/00 wide paper # 7 are objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. Therefore, the added new material which is not supported by the original disclosure forms the basis for above 112 para one rejections.

Applicants are required to cancel the new matter in the reply to this Office action

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*Conclusion*

3. Applicant's amendments to claims 1, 6 necessitated the new ground(s) of rejection of claims 1-4, 6-9 presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

In view of above facts, the rejections under 35 U.S.C. § 112; 35 U.S.C. § 103 and 35 U.S.C. 102 are **not** withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhaker Patel whose telephone number is (703) 308 4709. The examiner can normally be reached on Monday thru' Friday from 8:30 AM to 5:00 PM. If attempts to reach

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the examiner by the phone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at (703) 308 4716.

A facsimile center has been established for Group 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or (703) 305-3592.

*Mukund J. Shah*

**Mukund Shah**

**Supervisory Patent Examiner**

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sp *[Signature]*

May 18, 2000